IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

APPEAL NO. 74 OF 2006
IN
NOTICE OF MOTION NO. 877 OF 2003
IN
SUIT NO. 806 OF 2003

1. Mr. Abdul Sattar, son of Late Mohammed Shafih, of Meerut Indian Inhabitant carrying on business and residing at 60, Shapir Jadid, Post No.348, Meerut-250002, Uttar Pradesh]

2. M/s. Pilot Nozzles Company, a sole proprietory concern of Appellant No.1 and having its office at 60, Shapir Jadid, Post No.348, Meerut-250 002, Uttar Pradesh] .. Appellants (Ori.Defs.1- 2)

Versus

M/s. Rails Engineering Works a registered Partnership Firm having its office at 21, Balaji Industrial Estate, Akurli Village, Kandivali (E) Mumbai - 400 101.] .. Respondents (Ori.Plaintiffs)

Mr. S.M. Sakhardande i/b Mr. S.N. Nair for the appellants.

CORAM: R.M. LODHA, &
S.A. BOBDE, JJ.

DATED: 20TH DECEMBER, 2006

JUDGMENT : [Per R.M. Lodha, J.]

. We heard Mr. S.M. Sakhardande, the counsel for the appellants.

2. The defendants are in Appeal from an order

dated 30th September, 2005, confirming the ad-interim order dated 24th March, 2003.

3. The plaintiffs (respondents herein) filed the Suit for infringement of registered trademark "PILOT" and passing off action against the defendants. The temporary injunction was also sought by the plaintiffs based on passing off action.

4. *Inter alia,* the defence of the defendants was that user of the mark "PILOT" by the defendants is prior in point of time to the plaintiffs' user thereof.

5. The learned Motion Judge confirmed the ad-interim order on two grounds. The first ground that weighed with the learned Motion Judge was that in cases where the mark was already registered, prior user is no defence. The other ground that pursuaded the learned Motion Judge was that the ad-interim order was in force since 24th March, 2003.

6. None of the grounds, in our opinion, justifies the impugned order.

7. Section 34 of The Trade Marks Act, 1999 seems to have been completely overlooked and ignored by the

learned Motion Judge.

8. Section 34 reads thus:

> "34. **Saving for vested rights.-** Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior -
>
> (a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or
>
> (b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his,
>
> whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first mentioned trade mark."

9. If Section 34 of The Trade Marks Act, 1999 was brought to the notice of the learned Motion Judge, ought we know what would have been the ultimate order on the Notice of Motion. The first ground may, therefore, not justify the impugned order.

10. Because the ad-interim order has been

operating from 24th March, 2003, would not justify the confirmation of the ad-interim order.

11. The cursory manner in which the Notice of Motion has been disposed of by the learned Motion Judge was not proper and justified. The matter requires a re-look and reconsideration.

12. We, accordingly, allow the Appeal and set aside the order dated 30th September, 2005. Notice of Motion No.877 of 2003 is restored to the file of the Motion Judge for fresh hearing and consideration.

. Order accordingly.

Sd/-
[R.M. LODHA, J.]

Sd/-
[S.A. BOBDE, J.]